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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILLSE, DAVID H

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,002

Applicant(s)

PHAM ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-32, 34-38 and 40 is/are rejected.
- 7) ☒ Claim(s) 33, 39 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5 pages.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to a method of manufacturing an intraocular lens, classified in class 264, subclass 2.5.
 - II. Claims 25-41, drawn to a method of inserting an intraocular lens into an eye of a patient, classified in class 606, subclass 107.

(Note: Although claims 14-24 are supposedly directed to a "lens", such a term is deemed to constitute a typographical error because the body of each of said claims sets forth method steps rather than product elements.)

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as with surgical methods in which the intraocular lens obtained by invention I is compressed, twisted, and/or folded in the manner taught in the prior art for insertion through a small incision, and invention II has separate utility such as with intraocular lenses formed, for example, by machining components and fusing them together (as opposed to the molding procedure of invention I). Attention is directed to MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent required searches, restriction for examination purposes as indicated is proper.

During a telephone conversation between Yewebdar T. Tadesse and Mark Kertz on August 13, 2004, a provisional election was made without traverse to prosecute invention II,

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claims 25-41. Affirmation of this election must be made by the Applicant in replying to this Office action. Claims 1-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In the Information Disclosure Statement of November 4, 2002, certain references were **not** considered because a concise explanation of the relevance (37 C.F.R. § 1.98(a)(3)) and/or a complete copy (37 C.F.R. § 1.98(a)(2)) was not presented: the copy WO 01/34067 is missing the first drawing sheet, and DE 195 01 444 A1 and FR 2 784 575 A1 are not in the English language. Regarding the Information Disclosure Statements of November 4, 2002, and March 31, 2003, copies of the listed U.S. patent applications are not present in the electronic file; the Applicant should provide evidence that such copies were submitted to the patent office in compliance with 37 C.F.R. §§ 1.97 and 1.98 in order to have these documents considered.

The Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claims (MPEP § 714.02) and must do so in response to the instant Office action.

The disclosure is objected to because of the following informalities: The beginning of the specification should be revised so as to make reference to U.S. provisional application serial no. 60/337,343. Appropriate correction is required.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 25-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hoffer, US 4,636,210, which discloses a first viewing element **41** connected to a second viewing element **39** and/or **43**. Regarding claim 27, first viewing element **41**, for example, comprises a perimeter frame member **45**.

Claims 25-32, 34-38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hecht, EP 0 162 573 A2, which presents a surgical procedure in Figures 27-32 and page 26, line 31, through page 28, line 27, but does not provide the particulars for implanting

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embodiments with more than one optic, such as those illustrated in Figures 4, 7, 17A, and 17B.

To move or bend the connecting or biasing elements so as to transversely displace said optics for insertion through the incision **103** (Figure 28) would have been immediately obvious, if not inherent, to one of ordinary skill in order to minimize the size of the incision and to circumvent the need to assemble components within the eye. Regarding claim 32, element **13"**, for example, may be viewed as a clip.

Claims 33, 39, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
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